

## REMARKS

The Official Action of 8 January 2007 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claims 5 and 10 have been rewritten in independent form to include all the limitations of the base claim (claim 1). Claims 1-4 and 7-9 have been canceled without prejudice. Claims 5, 10-12 and 14-18 are pending in this application.

The claims stand rejected under 35 USC 103(a) as allegedly being unpatentable over Kamikubo. Applicants respectfully traverse this rejection.

The invention defined in the claims of record is based at least in part upon Applicants' discovery that, although certain beneficial effects are obtained by maintaining the Ra of the protective layer-laminating surface of the claimed image-protective film in a range of about 0.2 to 0.5, it is surprisingly possible to achieve even greater advantageous effects by also including in the claimed image protecting film a high Tg emulsion and a silica/wax. This is shown by the Examples in the present specification, as discussed below.

First, Applicants respectfully note that the premise for the rejection is that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation" (Office Action at paragraph bridging pages 2-3). However, the present specification shows the result effective nature of parameters which the cited art does **not** recognize to be result effective, such that it could not have been *prima facie* obvious to optimize them. See MPEP 2144.05 ("A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).").

In this respect, the examples described in the specification show the criticality of the surface roughness of the support **and** the inclusion in the claimed image protecting film of a high Tg emulsion, a silica/wax or, preferably, both. In the Examples, each of Examples 1-5 comprises an image protecting film on a support having an Ra within the claimed range whereas Comparative Examples 1 and 2 have supports wherein the Ra is above (Comparative Example 2) or below (Comparative Example 1) the claimed range (see Table 1 on page 33 of the specification). The image protecting film of Examples 1-3 contain both a high Tg emulsion and silica/wax whereas the image protecting film of Example 4 contains the former but does not contain the latter, and the image protecting film of Example 5 does not contain the former but does contain the latter (see Table 1).

As shown in Table 2 on page 42 of the specification, each of Examples 1-5 performed better than Comparative Example 1 in the evaluation for “Matte Feeling” and each performed better than Comparative Example 2 in the evaluation for “Transferability” and “Color Developability”. (The evaluation criteria are described in the specification at pages 34-41.) Significantly, Examples 1-3, containing both the high Tg emulsion and the silica/wax, performed better than Examples 4 and 5, containing only either the high Tg emulsion or the silica/wax, in a number of evaluations, including “Transferability”, “Cuttability of Edges”, “Blocking Resistance”, “Scratch Resistance” and “Storage Stability in Album” (see Table 2).

In contrast, the cited reference describes only the addition of a slipping property-imparting agent (paragraph [0040]) or organic or inorganic filler (paragraphs [0054] and [0061]) to the protective layer. However, the reference does not show or suggest any specific details thereof or effects provided by these optional additives, and indeed the preferred embodiments in the Examples do not contain any such agent or filler. Moreover, the reference is silent as to the use of a high Tg emulsion. Accordingly, there is nothing in the reference to show or suggest (a) that the glass transition temperatures of the recited thermoplastic resins are result-effective variables, or (b) the advantageous effects provided to the claimed image protective film by a high Tg emulsion and silica/wax.

Since the reference does not show or suggest the result effective nature of the glass transition temperatures of the recited thermoplastic resins, it cannot be said that the optimization of such variables would have been obvious to one of skill in the art. See MPEP Section 2144.05(II)(B) Accordingly, the reference cannot set forth even a *prima facie* case of obviousness for the invention as defined in the claims as amended.

Even assuming for the sake of argument that the references could be considered to set forth a *prima facie* case of obviousness, the evidence in the specification of unexpectedly advantageous results with the claimed invention and, in particular, the high Tg emulsion and silica/wax recited in the claims would be sufficient to rebut the alleged *prima facie* case (see discussion above). Accordingly, it is respectfully submitted that the prior art rejection of record has been overcome with respect to all claims and should be withdrawn.

In view of the above, it is respectfully submitted that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



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CLIFFORD J. MASS

LADAS & PARRY LLP

26 WEST 61ST STREET

NEW YORK, NEW YORK 10023

REG. NO.30,086(212)708-1890 .